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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,909	08/07/2003	John Butler	08203.0003-02	7820
22852	7590	02/07/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			O CONNOR, CARY E	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/635,909	Applicant(s) BUTLER ET AL	
	Examiner Cary E. O'Connor	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-30-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-23, 25, 26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15-18, 20-23, 25, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 10, 14 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>123003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 2, the word "means" is preceded by the word(s) "annular ring" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 10, 13 and 11 of U.S. Patent No. 6,254,534 in view of Kaji (6,033,426). The claims of patent do not set forth a means to seal the retracted wound opening. Kaji shows a surgical device comprising a wound retractor comprising a retracting member 3 for insertion into a wound opening, and a proximal member 14 for location externally of the wound opening. The proximal member is movable relative to the retracting member to shorten the extent of the retracting member to laterally contract the wound opening (see Figures 4A and 4B). The device also includes means 2 to seal the retracted wound opening wherein the sealing means is integral with the retractor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the claimed retractor with a means to seal the wound opening in view of Kaji in order to maintain an air-tight state of the cavity even when an object is to be inserted.

Claims 11-13 and 15-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 12 of U.S. Patent No. 6,623,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is well settled that the omission of an element and its function (in this case, the omission of the second ring) is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963) and Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 8, 9, 18, 20-23, 25, 26, 28 and 29 are rejected under 35

U.S.C. 102(e) as being anticipated by Beane et al (5,906,557). Beane shows a surgical device comprising a wound retractor comprising a retracting member 66 for insertion into a wound opening, and a proximal member (annular rings 68, 69) for location externally of the wound opening. The proximal member is movable relative to the retracting member to shorten the extent of the retracting member to laterally contract the wound opening (see figures 2C, 2D and 2E). The device also includes means 62 to seal the retracted wound opening wherein the sealing means is integral with the retractor. The sealing means comprises a sleeve having an inner sleeve section 14 and an outer sleeve section 10 with a chamber defined therebetween. As to claims 22 and 23, Figure 3 shows the chamber overlapping the proximal member at a proximal side of the proximal member.

Claims 1, 2, 18, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaji (6,033,426). Kaji shows a surgical device comprising a wound retractor comprising

a retracting member 3 for insertion into a wound opening, and a proximal member 14 for location externally of the wound opening. The proximal member is movable relative to the retracting member to shorten the extent of the retracting member to laterally contract the wound opening (see Figures 4A and 4B). The device also includes means 2 to seal the retracted wound opening wherein the sealing means is integral with the retractor.

Claims 11, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Grodecki et al (5,045,070). Grodecki shows a surgical device comprising a retracting member 17 movable from an insertion configuration (Figure 2) for insertion into a wound opening to a retracting configuration (Figure 3) to retract laterally the wound opening, and a sleeve 10 integral with the retracting member. The sleeve having an inner sleeve section 13 and an outer sleeve section 15 with a chamber 14 for receiving pressurized fluid defined therebetween. The sleeve is evertable upon advancement of an object through the sleeve (see Figure 3). As to claim 13, the sleeve is turned axially back on itself to define the sleeve sections. As to claim 15, note the distal member 19 coupled to the distal end of the retracting member. As to claim 16, note that the distal end is made of a resilient material (the entire retracting member is flexible).

Allowable Subject Matter

Claims 10, 14 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the inner sleeve being twisted (claims 14 and 30) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cary E. O'Connor
Primary Examiner
Art Unit 3732

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